

REMARKS

By the present amendment, the specification has been amended. No new matter has been added.

Claims 1-49, 77-84, 87, 88 and 90 remain pending in the application. Claims 50-76, 85, 86, 89, 91 and 92 were previously canceled. Reconsideration and allowance of all of the claims is respectfully requested in view of the following remarks.

In regard to Rejection of Claims 1-49, 77-84, 87-88 and 90 Under 35 USC §112, first paragraph

The Examiner has rejected claims 1-49, 77-84, 87-88 and 90 Under 35 USC §112, first paragraph, as failing to comply with the written description requirement, on the basis that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicants disagree.

Specifically, the Examiner asserts that

applicant's original disclosure does not refer to a tunnel, but rather simply a "frame". Even applicant's Canadian patent application, which he has incorporated by reference, does not describe a piece of bent metal. It shows a frame 10 with a tunnel area 27, but does not indicate it is formed from a single sheet of metal. In fact, a tunnel could be formed from any number of materials, including plastics and composites. Therefore, the recitation of a tunnel formed from a bent sheet of metal is believed to be new matter.

The Applicants disagree.

The Applicants wish to reiterate their remarks in the communication filed on October 9, 2007, which the Examiner appears not to have considered, that the claims do not recite a tunnel "formed from a single sheet of metal", and as such a specific description of a single sheet of metal is not required to support the claims.

The Examiner has stated on page 15 of the rejection that

Applicant has [...] failed to point out specific places in his specification, including the detailed description, background of the invention, or drawings, that provide such support. Applicant's affidavit submitted October 09, 207 [sic], and executed by Jean-Yves Lablanc [sic], indicates the construction of the disclosed structure would "inevitably be made of sheet metal", but still fails to identify the teaching in the present disclosure for such a construction. The fact that such structure is abundantly obvious in view of conventional methods of manufacturing snowmobiles does not mean there is support in applicant's disclosure for such structure to be claimed.

By the present amendment, the Applicants have amended lines 19-21 of page 9 of the specification to recite a tunnel made of bent sheet metal. The Applicants submit that as a result of the present amendment, the present disclosure specifically teaches a "tunnel including at least one piece of bent sheet metal" as recited in the claims. The Applicants believe that the claims are now properly and explicitly supported by the specification as amended. No new matter has been added, as the bent sheet metal construction of the tunnel of the present invention is believed to have been inherently disclosed in Canadian Patent Application No. 2,256,944 (the "Canadian Application"), to which the present application claims priority, as was discussed in the communication filed on October 9, 2007 and as will be discussed in further detail below.

The Examiner has stated on page 16 of the rejection that

[t]he affidavit and arguments have not shown that such structure is inherent to applicant's disclosed invention or required in every instance. Therefore, the affidavit does not on its face overcome the new matter rejection under 35 U.S.C. 112, first paragraph.

The Applicants submit that the Leblanc declaration filed on October 9, 2007, together with the remarks filed concurrently therewith, establish that the particular tunnel structure disclosed in the Canadian Application would inevitably and in every case be made of bent sheet metal, that a person skilled in the art would only ever construct the tunnel shown from bent sheet metal, and that the declarant was unaware of any production snowmobile before or since the filing of the Canadian Application having a tunnel made of a material other than bent sheet metal. Thus, the disclosed structure would, in every instance, be made of sheet metal, and this would be readily understood by a person skilled in the art. As such, Figure 11

of the Canadian Application teaches a person skilled in the art, either explicitly or inherently, that the tunnel shown therein is made of bent sheet metal.

The Examiner has stated on page 16 of the rejection that

[t]he affidavit submitted by Jean-Yves Leblanc is also not adequate evidence to overcome the new matter rejection. The affidavit is essentially one individual's opinion. The declarant is an employee of the assignee of the present application, not an objection [sic] party.

The Applicants submit that every declaration under Rule 132 is necessarily one individual's opinion, and as such the Examiner is not entitled to give the declaration less consideration on this basis. Furthermore, the declarant's status as an employee of the assignee is not a proper basis to discount the contents of the declaration without some indication that the statements are untrue or inaccurate, which indication the Examiner has not even attempted to provide. Indeed, the declarant's position as an employee of the assignee provides a motivation for the declarant to be truthful, because any false statements made in his declaration could render the patent that would issue from the present application invalid or unenforceable in subsequent litigation. The declarant was selected because he has extensive experience in the field of snowmobiles, as set out in his declaration, and because of his familiarity with the snowmobile designs of the assignee and its competitors. In addition, as an employee of the assignee he was readily available to give his assessment of the state of the art. The statements in the Leblanc declaration filed on October 9, 2007 reflect not merely Mr. Leblanc's personal opinion, but his understanding of the state of the knowledge in the relevant art at the relevant time. The Examiner has provided no indication that the state of the knowledge in the art was different from that described by Mr. Leblanc.

The Examiner has stated on page 16 of the rejection that

the affidavit does not cite objective sources to establish that the claimed structure is part of applicant's disclosed invention. Therefore, the affidavit is believed to be inadequate evidence of the presence of the claimed teaching.

The Applicants submit that the purpose of the Leblanc declaration is to establish what a person skilled in the art at the relevant date would understand the Canadian Application to disclose. Mr. Leblanc, a person of extensive experience in the relevant art, has described what

he understands the Canadian Application to teach, and what he believes a person working in the snowmobile industry would understand it to teach. If the Examiner desires more objective evidence of the state of knowledge in the art than the sworn statement of a person knowledgeable in the art, she has only to turn to her own rejection, which contains a citation on page 9 of Marier, which predates the Canadian Application and teaches a tunnel formed of sheet aluminum; a citation on page 3 of Yasui, which describes a "conventional snowmobile" of its day as having a tunnel made with steel stampings; a reference on page 15 to a tunnel made of sheet metal as "abundantly obvious in view of conventional methods of manufacturing snowmobiles"; and an allusion on page 17 to "any number of additional references" teaching a tunnel containing bent sheet metal.

The Examiner has stated on page 16 of the rejection that

[m]odern composites can be as strong and lighter in weight than conventionally used metals. Such composites are routinely used in the manufacture of structural elements formerly made from metal in bicycles, automobiles, aircraft, etc. There is nothing inherent to snowmobiles that would not allow composites to be used in the manufacture of their frames. Applicant's tunnel is not inherently made from bent sheet metal. Therefore, without a specific teaching, applicant's disclosed invention does not teach a bent sheet metal tunnel.

The Applicants disagree with the Examiner's statement. The Applicants note that the Examiner's statement is in direct contradiction with the explicit statement in the Leblanc declaration that composite materials are unsuitable for use in constructing snowmobile tunnels. In addition, the Applicants note that the Examiner has not provided any evidence in support of her bare assertion that snowmobile frames could be made of composite materials. The Examiner has not established that the use of composite materials to replace metal components was commonplace at the time of filing of the Canadian Application or at any other date relevant to the present application. In addition, despite the Examiner's assertion that composites are as strong as and lighter than metals, and are generally advantageous and commonplace in other applications where metal was formerly used, the Examiner has not provided a single example of a prior art snowmobile, or even a more recent snowmobile, having a tunnel made of composite material or any material other than sheet metal. In addition, Mr. Leblanc is not aware of a single such snowmobile, either prior art or non-prior art, in his many years of experience in the snowmobile industry.

Therefore, the Applicants submit that the recitation in claims 1-49, 77-84, 87-88 and 90 of a "tunnel including at least one piece of bent sheet metal" is supported by the application as originally filed, and the Examiner's rejection should be withdrawn.

In regard to Rejection of Claims 1-49, 77-84 and 87-88 Under 35 USC § 103(a)

The Examiner has rejected claims 40-43, 45-49, 77-82 and 88 under 35 U.S.C. § 103(a), as being unpatentable over Yasui, U.S. Patent No. 4,848,503, in view of "The Seated Man (Homo Sedens) The seated work position Theory and Practice" by A.C. Mandal and Marier, U.S. Patent No. 5,660,245.

The Examiner has rejected claim 83 under 35 U.S.C. § 103(a), as being unpatentable over Yasui in view of Mandal and Marier, and further in view of Stacy, U.S. Patent No. 3,692,130.

The Examiner has rejected claims 6-39 and 44 under 35 U.S.C. § 103(a), as being unpatentable over Yasui in view of Applicants' Admitted Prior Art (AAPA) and Marier.

The Examiner has rejected claims 1-5, 84 and 87 under 35 U.S.C. § 103(a), as being unpatentable over Yasui in view of AAPA, Marier and "The Complete Snowmobile Handbook" by Dempsey.

The Applicants disagree with all of the above rejections.

The Applicants reiterate their remarks as filed on October 9, 2007 regarding the allowability of claims 1-49, 77-84 and 87-88.

In addition, the Applicants wish to address the Examiner's remarks on pages 15-18 of the rejection.

The Examiner has stated on pages 16-17 of the rejection that

Applicant argues that Yasui teaches away from using a heavy stamped steel tunnel structure and, therefore, teaches away from using a tunnel made from bent sheet metal. Marrier [sic], however, teaches a light weight tunnel structure made from bent aluminum. Yasui specifically refers to "steel stampings" (col. 1, lines 17-18). The teaching in Marrier [sic] is not of a

heavy stamped steel and, therefore, is not the structure taught away from in Yasui.

The Applicants refer the Examiner specifically to pages 21-22 of the remarks filed on October 9, 2007, wherein the Applicants explained in detail that Yasui teaches away from not only a stamped steel frame, but any sheet metal frame regardless of the metal used.

The Examiner has stated on page 17 of the rejection that

Yasui promotes the concept of a light-weight tubular framework, but does not eliminate the possibility of the use of some bent metal sheet material in construction of the tunnel area, for reinforcement or to channel snow and prevent it jamming between the track and the frame. Applicant has made it abundantly clear through arguments and the affidavit that such a tunnel structure is highly advantageous and commonly used in the manufacture of snowmobiles.

The Examiner has provided no supporting evidence for her assertion that Yasui would suggest to a person skilled in the art to use some bent metal sheet material in construction of the tunnel area. In particular, Yasui does not even disclose a tunnel, as the term would be understood by a person skilled in the art. By extension, Yasui does not teach any particular construction of a tunnel structure or tunnel area. In addition, as the Applicants stated in the remarks filed on October 9, 2007 and as reiterated above, Yasui explicitly teaches away from the use of a sheet metal tunnel. The Examiner's assertion that sheet metal could be used for reinforcement or to channel snow is speculative, unsupported by the disclosure of Yasui, and in direct contradiction with Yasui's teaching away from the use of bent sheet metal. Even assuming, as the Examiner asserts, that a tunnel made of bent sheet metal is "highly advantageous and commonly used in the manufacture of snowmobiles", a bent sheet metal tunnel is precisely the construction that Yasui teaches not to use, and precisely the construction that creates the supposed disadvantages Yasui purports to address. As such, a bent sheet metal tunnel cannot be combined with Yasui, regardless of how commonly used it may be in the manufacture of conventional snowmobiles.

The Examiner has stated on page 17 of the rejection that

[i]t appears that Yasui includes a number of bent sheet metal elements in the frame, including a cross piece connecting sides of element 24 (seen in Figure 2), pads 21, and channel member

26. Therefore, the examiner maintains that it would have been obvious to make the tunnel of Yasui with at least one piece of bent sheet metal in view of the teaching of Yasui in combination with any number of additional references, as indicated above.

The Applicants disagree with the Examiner's interpretation of Yasui. In particular, it would not be obvious to make the tunnel of Yasui with at least one piece of bent sheet metal because Yasui does not teach a tunnel of any kind. In addition, the features of Yasui identified by the Examiner do not suggest to a person skilled in the art to add to Yasui a tunnel containing bent sheet metal. There is no indication in Yasui that the cross piece connecting the sides of element 24 is made of bent sheet metal, particularly in view of Yasui's emphasis on a tubular frame construction and explicit teaching away from a frame made of bent sheet metal. The pads 21 similarly do not form part of a tunnel, nor are they located in an area where the tunnel would be placed on a conventional snowmobile. The channel member 26 supports the front suspension system for the skis 13 of Yasui, and as such is situated far from where the tunnel would be placed on a conventional snowmobile, and neither forms part of the tunnel nor suggests a tunnel made with bent sheet metal. The mere presence of isolated parts on the vehicle of Yasui that the Examiner assumes to be made of sheet metal does not amount to a teaching of a tunnel containing sheet metal, particularly when those parts are not located where a tunnel would be positioned on a conventional snowmobile, and particularly in view of Yasui's explicit teaching away from a bent sheet metal frame.

Regarding Mandal, the Examiner states on page 17 of the rejection that

Mandal discusses comfortable seating positions on stationary seats as well as while straddling a horse while riding (see p. 2 or [sic] Mandal). It provides basic teaching regarding human physiology and ergonomic seating design. While additional considerations may be taken into account when designing a snowmobile, the teachings of basic comfort sitting positions, taught by Mandal, are applicable to snowmobiles as well.

The Applicants disagree with the Examiner's statement. The Applicants note that the Examiner's statement is in direct contradiction with the explicit statement in the Leblanc declaration that the teachings of Mandal are not applicable to snowmobiles because the ergonomics of sitting and the concept of basic comfort sitting positions is not relevant to an art where the person changes positions frequently and does not maintain a constant posture.

The Examiner has provided no factual basis for her bare assertion that Mr. Leblanc's statement based on his experience in the snowmobile industry is in any way inaccurate.

The Examiner's attention is directed to paragraphs [0062]-[0086] of the declaration of Jean-Yves Leblanc filed herewith, providing extensive evidence that the ergonomics of snowmobiles according to the present invention were received by the snowmobile industry as a radical innovation. The Examiner's attention is additionally directed to paragraphs [0087]-[00123] of the declaration of Jean-Yves Leblanc filed herewith, providing extensive evidence of the commercial success of snowmobiles with ergonomics according to the claimed invention. The Examiner's attention is additionally directed to paragraphs [00124]-[00158] of the declaration of Jean-Yves Leblanc filed herewith, providing extensive evidence that after the assignee introduced snowmobiles with ergonomics according to the claimed invention, the novel ergonomics were copied by the competitors of the assignee. This suggests that rider ergonomics in general, and ergonomics according to the claimed invention in particular, were not an issue that figured prominently in snowmobile design in the several decades of development that preceded the filing of the present application. Therefore, even if the teachings of Mandal were theoretically applicable to snowmobiles, which the Applicants deny, a person skilled in the art of snowmobile design would not have looked to Mandal because it was not known in the art to modify the ergonomics of the rider.

The Examiner states on page 18 of the rejection that

Applicant argues that the teachings of Yasui are not combinable with conventional snowmobile designs. However, applicant fails to distinguish the Yasui design from what is "conventional". The Yasui vehicle may be somewhat small in scale but it includes all of the standard features of a snowmobile, including two front skis, a forwardly mounted engine, a rear mounted track, a straddle seat in a central area, etc. The examiner maintains that the Yasui design contains all of the basic features of what is generally understood to be a "conventional" [sic] with the basic snowmobile components conventionally positioned and lends itself readily to combination with teachings from other snowmobile designs.

As the Applicants have clearly stated on page 20 of the remarks filed on October 9, 2007, Yasui itself describes a conventional snowmobile as having a frame made up of a plurality of steel stampings welded together. The Yasui design explicitly lacks this feature,

and specifically teaches away from a stamped sheet metal frame in general as discussed above and in the remarks filed on October 9, 2007. The Leblanc declaration filed on October 9, 2007 makes a similar distinction between Yasui and conventional snowmobiles. While, as the Examiner points out, Yasui has some of the other basic components of conventional snowmobiles, the primary difference between Yasui and conventional snowmobiles remains the conspicuous absence in Yasui of a bent sheet metal tunnel. The Applicants have not argued that Yasui could not be combined with some other prior art ski, engine, drive track or straddle seat. The Applicants maintain that Yasui cannot be combined with the teachings of a sheet metal tunnel from other snowmobile designs, because of Yasui's explicit teaching of an alternative structure to address the purported deficiencies of a stamped sheet metal frame.

The Examiner states on page 18 of the rejection that

Applicant argues that the examiner incorrectly situates the c.g. position of Yasui and that Yasui does not weight [sic] 900 pounds. However, it provides no evidence that this is the case. The examiner has relied on the suggestions of the prior art for estimations as to the positioning of the centers of gravity. The prior art of record suggests that the c.g. positioning claimed is obvious.

The Applicants submit that it is not the Applicants' responsibility to conclusively demonstrate that Yasui does not weigh 900 pounds, but rather that it is the Examiner's responsibility to provide a reasonable factual basis for the measurements on which she relies in formulating her rejection. As the Applicants stated in the remarks filed on October 9, 2007, the weights of seemingly randomly selected vehicles from different time periods and bearing little structural similarity to Yasui are not a sound basis for estimating the weight of Yasui, particularly when a major design concern of Yasui is that it be more lightweight than conventional snowmobiles of its day.

By way of example, the Examiner's attention is directed to the final three pages of Exhibit F to the Leblanc declaration filed herewith. It is apparent that in model year 2000, even the heaviest Polaris snowmobile, the Widetrak LX designed for two riders, weighed 619 pounds. Referring to Exhibit L to the Leblanc declaration filed herewith. It is apparent that in model year 2000, the heaviest Arctic Cat snowmobile, the Bearcat Widetrack designed for two riders, weighed 671 pounds. Referring to Exhibit Q to the Leblanc declaration filed herewith. It is apparent that in model year 2000, the heaviest Yamaha snowmobile, the VK

540 III designed for two riders, weighed 642 pounds. Referring to Exhibit X to the Leblanc declaration filed herewith. It is apparent that in model year 2000, the heaviest BRP snowmobile, the Grand Touring SE designed for two riders, weighed 671 pounds. Every other production snowmobile manufactured by these companies was respectively lighter than these models. As such, the Examiner's assertion that the "small snowmobile" of Yasui, designed for a single rider, specifically designed without a sheet metal frame to be lightweight, and described by the Examiner on page 18 of the rejection as "somewhat small in scale" has a weight of 900 pounds defies all common sense.

In addition, the Examiner is invited to consider in its entirety the declaration of Jean-Yves Leblanc filed herewith, containing extensive factual evidence of non-obviousness. The evidence speaks for itself, and it will not be described in further detail herein.

In view of the above remarks and the declaration of Jean-Yves Leblanc filed herewith, the Applicants believe that claims 1-49, 77-84 and 87-88 are patentable over the cited references, alone or in combination, which combination is denied, and the Examiner is requested to withdraw her rejection.

In view of the above remarks, the Applicants respectfully submit that all of the currently pending claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in a better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

At the time of filing of the present response, the Office was authorized to charge the fees believed to be necessary to a credit card. In case of any under- or over-payment or should any additional fee be otherwise necessary, the Office is hereby authorized to credit or debit (as the case may be) Deposit Account number 502977.

Respectfully submitted,

/ Jonathan D. Cutler /

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